

REMARKS

Favorable consideration of this Application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-8 are pending in the present Application. No new matter has been added.

By way of summary, the Official Action presents the following issues: Claims 1-5, 7, and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Levine (U.S. Patent No. 5,692,214) in view of Elliot (U.S. Patent No. 6,590,503); and, Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Levine in view of Elliot as applied to Claim 1, and further in view of Saward (U.S. Patent No. 5,537,473).

REJECTION UNDER 35 U.S.C. § 103

The outstanding Official Action has rejected Claims 1-5, 7, and 8 under 35 U.S.C. § 103 as being obvious over Levine in view of Elliot. The Official Action asserts that Levine discloses all of the Applicants' claimed features, with the exception of automatically obtaining code information from a server apparatus. However, the Official Action cites Elliot as disclosing this more detailed aspect of the Applicants' invention, and states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cited references for arriving at the Applicants' claims. Applicants respectfully traverse the rejection.

Claim 1 recites, *inter alia*, an information processing apparatus, including:

. . . code information acquiring means for acquiring, on the basis of said identification information acquired by said identification information acquiring means, code information for controlling said recording apparatus, said code information being automatically obtained from a server apparatus if unavailable in a local memory, said code information correspondingly employed with said control information acquired by said control information acquiring means. . .

Levine describes a system for enabling an unattended recording of a program to a video tape recording device. A television recording and receiving system (10) includes a television receiver (12), a video cassette recorder (14), and a cable tuner and descrambler box (16). A personal computer (18) is provided with an application program for implementing the program schedule for use in conjunction with the television recording and receiving system. In operation, the personal computer accesses a remote database (40) for obtaining a program schedule.¹ The IR unit (26) transmits control signals to the VCR for initiating a recording operation based upon a predetermined program schedule, as selected by a user. To perform a transmission function, the personal computer requires information as to the nature of the remote control codes used by the video recorder and/or the cable box. This information is provided during a routine of the application program, in which the operator keys in the identification of the make and model of the VCR and cable box.² Alternatively, the appropriate codes may be learned from operation of a remote control in conjunction with the IR sensor (32).³

Elliot describes a remote control system (100), which includes communication circuitry (114).⁴ The communication circuitry is described as either a modem or memory cartridge reader.⁵ The function of the communication circuitry is described as being an alternative to a pre-programmed memory in that a code library may be downloaded to the memory via the communication circuitry.⁶

Conversely, in an exemplary embodiment of the Applicants' invention, an information processing apparatus is provided, in which code information corresponding to a

¹ Levine at Fig. 1; column 3, lines 7-53.

² Levine at column 4, lines 63-65.

³ Levine at column 4, line 65 through column 5, line 7.

⁴ Elliot at Fig. 2.

⁵ Elliot at column 3, lines 39-59.

⁶ Elliot at column 3, lines 40-42 and 48-53.

recording apparatus is automatically obtained from a server if the code information corresponding to the recording apparatus is not available in a local memory of the information processing apparatus.⁷

There is no disclosure, or suggestion, in Elliot of code information acquiring means and its associated function of automatically obtaining code information from a server if unavailable in a local memory. The required analysis of identifying corresponding structure and associated functions in the cited reference has not been performed. In this regard, the U.S. Patent and Trademark reviewing court recently emphasized that conclusory findings that omit analysis as to "means" claim limitations are improper in Gechter v. Davidson 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

In addition, the [PTO] never construed the scope of the structures disclosed in the specification for the claimed "receiving means," nor did the [PTO] expressly find that the "receiving means" disclosed in the specification was structurally equivalent to that embodied in [the reference]. Moreover, the [PTO] also failed to define the exact function of the receiving means, as well as to find that [the reference] disclosed the identical function. (emphasis added, citation omitted.)

There has not been any identification in the text of Elliot of any feature of a communication circuitry (114), which enables an automatic download. Thus, it appears that the outstanding Office Action is relying on conjecture or unfounded assumptions in suggesting that Elliot discloses, or suggests, a code information acquiring means or that such code information acquiring means is disclosed, or suggested, by Elliot to automatically download code information.

However, this is clearly a modification of the actual teachings found at col. 3, lines 39-42 and 44-47 and such a modification to actual reference teachings using unfounded assumptions and/or speculation is improper. *See In re Warner*, 379 F.2d 1011, 1017, 154

⁷ Application at Fig. 5.

USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

As neither Levine, nor Elliot, disclose or suggest automatically providing code information corresponding to a recording apparatus when that information is not available in a local memory, Applicants respectfully submit that amended Claim 1, and any claim depending therefrom, is allowable over the cited reference. As independent Claims 7 and 8 recite substantially similar limitations to that discussed above, Applicants respectfully submit that these claims, and any claims depending therefrom, are likewise allowable over the cited references.

Accordingly, Applicants respectfully request that the rejection of Claims 1-8 under 35 U.S.C. § 103 be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

The outstanding Official Action has rejected Claim 6 under 35 U.S.C. § 103 as being unpatentable over Levine in view of Elliot as applied to Claim 1, and further in view of Saward. The Official Action cites Levine and Elliot as disclosing all of the Applicants’ claim limitations, with the exception of control information including a broadcast date. The Official Action cites Saward as disclosing this more detailed aspect of the Applicants’ invention, and states that it would have been obvious to one skilled in the art at the time the invention was made to combine the cited references for arriving at the Applicants’ claims. Applicants respectfully traverse the rejection.

As noted above, the combination of Levine and Elliot do not disclose all of the elements for which it has been asserted. As Saward does not remedy the deficiency discussed

above, Applicants respectfully submit that a *prima facie* case of obviousness has not been presented. Accordingly, Applicants respectfully request that the rejection of Claim 6 under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted that the present Application, including Claims 1-8, is patently distinguished over the prior art, in condition for allowance, and such action is respectfully requested at an early date.

Respectfully submitted,

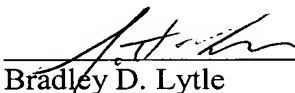
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

BDL:SAM:ycs



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Scott A. McKeown
Registration No. 42,866